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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,489	09/27/2001	Tetsuji Fuwa	110732	9315
<div>25944      7590      07/24/2007</div> <div>OLIFF &amp; BERRIDGE, PLC</div> <div>P.O. BOX 19928</div> <div>ALEXANDRIA, VA 22320</div>				
			<div>EXAMINER</div> <div>O'CONNOR, GERALD J</div>	
			<div>ART UNIT</div> <div>3627</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE</div> <div>07/24/2007</div>	<div>DELIVERY MODE</div> <div>PAPER</div>

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/963,489

Applicant(s)

Fuwa

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on December 8, 2005 and February 9, 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-34 is/are pending in the application.
- 4a) Of the above claim(s) 10-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on September 27, 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20070619
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Previous Office Action Vacated***

1. The previous Office action, mailed June 1, 2005, is hereby vacated, and should be entirely disregarded by applicant. Accordingly, no reply thereto by applicant is required, though a reply to the instant Office action is, of course, now required in order to avoid abandonment.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 9, 2006 has been entered.

### ***Preliminary Remarks***

3. This Office action responds to the arguments filed by applicant on December 8, 2005 and to the amendment and arguments filed by applicant on February 9, 2006, both of which were filed in reply to the previous Office action on the merits, mailed September 9, 2005.
4. The amendment of claim 1 by applicant in the reply filed on February 9, 2006 is hereby acknowledged.

***Election/Restriction***

5. Claims 10-34 continue to stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed January 10, 2005.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over von Rosen et al. (US 6,493,677).

Von Rosen et al. disclose a method for selling, over a transmission network, unique information indicating products that indicate unique information, the method comprising: receiving, at a server, unique information supplied from a client device across the transmission network to the server; preparing, based on unique information, a preview image of a unique information indicating product that indicates the unique information; transmitting the prepared preview image to the client device; and displaying the preview image using a browser of the client device, wherein the displayed preview image includes text displayed in a text font for the unique information indicating product, but the method of von Rosen et al. does not explicitly

include that the step of displaying includes displaying, using the browser of the client device, a plurality of preview images corresponding to different text fonts selectable for the unique information indicating product, nor do von Rosen et al. explicitly disclose an embodiment wherein the particular intended usage of the method (i.e., the particular products being sold) is directed to selling products selected from a group consisting of stamps and business cards.

However, displaying text in various fonts in order to vary the appearance of the text is certainly a well known, hence obvious, step to include in any method of customizing the appearance of graphical information containing text, and official notice to that effect is hereby taken. Additionally, selling customized products, wherein the customized products being sold are selected from a group of products consisting of stamps and business cards, is also a well known, hence obvious, step to those of ordinary skill in the art, and official notice to that effect is hereby taken.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of von Rosen et al. so as to include functionality to selectably display the text in different fonts, as is well known to do, in order to allow the customer to have greater control over the appearance of the product, and to apply the method of sales of customized products to the sale of particular products selected from a group consisting of stamps and business cards, as is also well known to do, merely as a matter of design choice, since so doing of each could be readily and easily performed by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claims 2 and 3, the steps of preparing and displaying of the method of von Rosen et al. are performed both in real time response to character input performed at the client

device for the unique information, as well as in response to a preview reception request sent from the client device to the server.

Regarding claims 4, 6, and 7, the step of displaying of the method of von Rosen et al. includes displaying, using the browser of the client device: a plurality of preview images corresponding to different colors selectable for the unique information indicating product; a plurality of preview images corresponding to different sizes selectable for the unique information indicating product; and, a plurality of preview images corresponding to different types selectable for the unique information indicating product.

Regarding claim 8, the step of receiving the unique information of the method of von Rosen et al. includes receiving a customer identifier; the step of preparing the preview image includes extracting, from a customer database that stores customer identifiers in correspondence with customer information, unique information associated with the customer identifier and preparing the preview image to indicate the extracted unique information on the unique information indicating product; and the step of displaying includes displaying the extracted unique information in the preview image of the unique information display product.

Regarding claim 9, the step of preparing of the method of von Rosen et al. includes preparing a customer identifier when the server receives unique information to be displayed on the unique information indicating product, but does not receive a customer identifier; and the step of transmitting the prepared preview image to the client device includes transmitting the prepared customer identifier.

***Response to Arguments***

8. Applicant's arguments filed December 8, 2005 and February 9, 2006 have been fully considered but they are not deemed persuasive.

9. Regarding the argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

10. Regarding the argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the knowledge generally available to one of ordinary skill in the art would include that text is inherently displayed in a font, that different fonts are available for changing the appearance of the text, and that allowing the customer to select the font for the text would give the customer greater control over the appearance of the product, which control would appeal to customers.

11. Regarding the argument that, "it is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based," the argument is irrelevant, since the statement of common knowledge in the art is indeed *not* the principal evidence upon which the rejection is based, the principal evidence upon which the rejection is based being von Rosen et al.

Furthermore, regarding the argument that the examiner has failed to provide a reference as evidence of what the examiner has found to be "well known" prior art, the argument has been disregarded as merely spurious, since challenging the existence of well known prior art by merely arguing that the fact is not supported by a reference, without stating for the record that the examiner is wrong or that applicant is without knowledge of the prior art teaching, does not constitute a proper traversal of the finding(s).

Lastly, in addition to being an improper traversal, the traversal also untimely, since any traversal must be made in the next response following the Office action which first made the statement as to what is considered to be "well known" or "common knowledge." In this case, the Office action that first made the statement as to what is considered to be "well known" or "common knowledge" was the non-final rejection mailed February 28, 2005. Applicant filed a response thereto on May 31, 2005, which response made no traversal of any "well known" or "common knowledge" statements. Therefore, the statements are thereafter been deemed admitted prior art. See MPEP § 2144.03(C).

Whereas any further traversal would no longer be seasonable, the object of any well known statements are therefore now deemed to be admitted prior art. See MPEP § 2144.03(C).



12. Regarding the argument that von Rosen et al. display “graphic images that are not defined by fonts,” von Rosen et al. indeed display graphic images that are defined by fonts. See, for example, Figure 7A, element 166. Clearly the “JONES” text is displayed in one font and the “SODA CO.” is displayed in a second font. Therefore, the graphic images displayed by the method of von Rosen et al. indeed comprises displaying graphic images that are defined by fonts.

13. Regarding the argument that von Rosen et al. do not specifically disclose an embodiment of their invention wherein the customized product being sold is selected from a group consisting of stamps and business cards, as claim 1, as now amended, now requires, the rejection has been amended to reflect the newly added recitations, indicating therein that the added recitations are considered to be directed merely to an obvious, self-evident, albeit different, intended use of the known prior art method. Note that none of independent claims 1, 8, or 14 of the von Rosen et al. patent mention any particular product, and that von Rosen et al. specifically mention that their method can be applied to the selling of other products. See, for example, column 5, lines 50-53.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to the disclosure.

15. All rejected claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry

under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

16. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

Official replies to this Office action may now be submitted electronically by registered users of the EFS-Web system. Information on EFS-Web tools is available on the Internet at: <http://www.uspto.gov/ebc/portal/tools.htm>. An EFS-Web Quick-Start Guide is available at: <http://www.uspto.gov/ebc/portal/efs/quick-start.pdf>.

Alternatively, official replies to this Office action may still be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies should be directed to the central fax at (571) 273-8300.**

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Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

July 6, 2007



7/6/07

Gerald J. O'Connor

Primary Examiner

Group Art Unit 3627